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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,600	04/13/2001	George Harry Hoffman	41556/04005 (RS11P098)	4406

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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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BOYCE, ANDRE D

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/834,600

Applicant(s)

HOFFMAN ET AL.

Examiner

Andre Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/7/01, 10/18/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS(s) 1/23/03, 6/03/03.

### **DETAILED ACTION**

1. Claims 1-15 have been examined.

#### ***Claim Objections***

2. Claim 3 is objected to because of the following informalities: there should be an --and-- after "data," in line 3. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case the independent claim 1 only recites an abstract idea. The recited steps of collecting benchmark data, categorizing the data, and comparing the data does not involve, use, or advance the technological arts (i.e., computer, processor, electronically, etc.), since the steps could be performed using pencil and paper.

Independent claim 6 recites a system, including logic with no components. Therefore, the claim is merely software per se, including functional descriptive material, and is non-statutory.

Independent claim 11 recites a computer program product, including computer code. The claim language does not indicate that the computer program product is embodied on a medium or executed on a computer. Therefore the claim is merely software per se, including functional descriptive material, and is non-statutory

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case independent claim 1 categorizes and compares benchmark data, thereby producing a useful, concrete, and tangible result, but not within the technological arts as explained above.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is rendered vague and indefinite, because it is a system claim with logic steps, but no components for executing the logic.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5, 6, 8, 10, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicher, Jr. et al (US 2002/0099598), in view of Myers (US 2002/0198808).

As per claim 1, Eicher, Jr. et al disclose a method for benchmarking in a supply chain utilizing a network (i.e., method to provide end-to-end performance based supply chain management, wherein aggregated content is used to generate benchmarking services, ¶ 0017 and ¶ 0065), comprising the acts of: collecting benchmark data relating to sales of products by outlets in a supply chain management framework (i.e., history of sales by products, derived from various sources, ¶ 0079), categorizing the benchmark data based on characteristics of the

outlets (i.e., generation of industry and cross-industry benchmarks based on content categories, including partner performance ratings, ¶ 0065), and comparing the benchmark data of each of the outlets (i.e., performance benchmark used to develop comparative performance profiles, ¶ 0191). Eicher, Jr. et al does not explicitly disclose feeding the comparison back to the outlets utilizing the supply chain management framework. Myers discloses participant in a supply chain benchmarked against other companies providing similar goods or services, wherein the supply chain information is used by management of the various participants as a diagnostic and guideline for improvement (¶ 0032). Both Eicher, Jr. et al and Myers are concerned with effective supply chain management, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include feeding the comparison back to the outlets utilizing the supply chain in Eicher, Jr. et al, as seen in Myers, so that the participants in the supply chain can use the information as a diagnostic and guideline for improvement, as disclosed by Myers, thus making the Eicher, Jr. et al system more effective.

As per claim 3, Eicher, Jr. et al disclose the characteristics of size (i.e., size of the company, ¶ 0168) and location (i.e., geographic location, ¶ 0168).

As per claim 5, Eicher, Jr. et al disclose the network includes the Internet (i.e., buyers and suppliers communicate to the server system via the internet, ¶ 0024).

Claims 6, 8, and 10 are rejected based upon the rejection of claims 1, 3, and 5, respectively, since they are the system claims corresponding to the method claims.

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Claims 11, 13, and 15 are rejected based upon the rejection of claims 1, 3, and 5, since they are the computer program product claims corresponding to the method claims.

9. Claims 2, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicher, Jr. et al (US 2002/0099598), in view of Myers (US 2002/0198808), as applied to claim 1, in further view of Landvater (USPN 6,609,101).

As per claim 2, neither Eicher, Jr. et al nor Myers explicitly disclose the benchmark data includes ratios of quantities of different products. Landvater discloses determining projected sales of a plurality of products in a supply chain, wherein projected sales are determined in accordance with a benchmark (column 4, lines 21-28). Further, Landvater discloses retrieving product group information listing different products in the group, wherein the quantity relationship is determined via a ratio (column 15, lines 57-62). Eicher, Jr. et al, Myers, and Landvater are concerned with effective supply chain management, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include benchmark data including ratios of quantities of different products in Eicher, Jr. et al, as seen in Landvater, as a useful tool for combining several products as a single entity for replenishment, as disclosed by Landvater (column 15, lines 27-31).

Claim 7 is rejected based upon the rejection of claim 2, since it is the system claim corresponding to the method claim.

Claims 12 is rejected based upon the rejection of claim 2, since it is the computer program product claim corresponding to the method claims.

10. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicher, Jr. et al (US 2002/0099598), in view of Myers (US 2002/0198808), as applied to claim 1, in further view of Swartz (TSI's Formula for Success, December 1997), in further view of Baldwin (Effects of Facilities on Hong Kong Supermarkets, January 1999).

As per claim 4, Eicher, Jr. et al disclose the characteristics include size (i.e., size of the company, ¶ 0168) and location (i.e., geographic location, ¶ 0168). Neither Eicher, Jr. et al nor Myers disclose sign and playground presence. Swartz discloses an organization involved in supply chain logistics (¶ 11), wherein characteristics of the company used to increase motivation include signage and a playground (¶ 27).

Neither Eicher, Jr. et al, Myers, nor Swartz disclose Nielson survey data and demographic data. Baldwin discloses the importance of demographic and site-specific factors in determining an organization location and viability (¶ 4). Further, Baldwin discloses Nielsen survey data used to determine a characteristic of an organization (¶ 15). Eicher, Jr. et al, Myers, Swartz, and Baldwin are concerned with effective organization response to customer/supplier need, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sign presence and playground presence, and Nielson survey and demographic data in Eicher, Jr. et al, as seen in Swartz, and Baldwin, respectively,



as an effective means of filtering potential partners, thereby making the system more robust and flexible.

Claim 9 is rejected based upon the rejection of claim 4, since it is the system claim corresponding to the method claim.

Claims 14 is rejected based upon the rejection of claim 4, since it is the computer program product claim corresponding to the method claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Phillips et al (US 2002/0116348) disclose a dynamic pricing system.

-Baseman et al (USPN 6671673) disclose generating a strategic business plan to improve operations.

-O'Sullivan (A New Breed of Benchmarking) discloses industry benchmarking.

-Waller et al (US 2003/0195791) disclose garners user input criteria necessary to analyze and communicate a redistribution of product demand.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number


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for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



adb  
April 17, 2005



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